

RCE application. These are:

(1)

On page 4, lines 4-6, the Board states:

Clearly the examiner is relying upon the "steel plate" or flanged-shaped member (1) as shown in Figure 4 as the starting point in the method of Kanemitsu...

Claim 5, however, does *not* start with a flanged-shaped member like that of Figure 4 of Kanemitsu. Claim 5 starts with the step of "holding the sheet metal member and forming from the sheet metal member a base plate, a stepped portion and a flanged-shaped portion." If claim 5 were starting with a flanged-shaped member like that of Figure 4 of Kanemitsu, then the recited first step of claim 5 would be meaningless. Formation is a positively recited method step. Existence, which is what we have with Figure 4 of Kanemitsu is not. Examination of the positively recited steps in a claim cannot be rendered meaningless by the examination. The fact is that claim 5 begins with what is shown in Fig. 1 of the present application, and such an orientation simply cannot be known from Kanemitsu. Kanemitsu does not tell us how the configuration of Figure 4 was achieved, and we are not permitted to assume that it was done according to the present invention. Such a conclusion assumes too much.

The rejection is anticipation under 35 USC 102 for claim 5. This section of the law does not permit us to assume what a reference teaches, it must specifically tell us what it teaches. There are any number of ways to arrive at the shape shown in Figure 4 of Kanemitsu. Since claim 5 is a method claim, how the part is made is paramount, not what it looks like.

(2)

On page 5, lines 7 - 12, the Board states:

At column 5, lines 50-52, in the discussion of another embodiment of the invention therein, Kanemitsu discloses that a member having a configuration like that seen in Figure 4 may be formed by beginning with a disc-like steel plate (e.g., Fig. 3), which may then be bent and formed into a flanged cup shape, as in Figure 4.

Here again too much is assumed. What Kanemitsu describes in these lines of column 5 is quite different than is assumed. If this description is followed, the steps would not resemble claim 5 at all. Kanemitsu instructs us to first form the "final thickened portion 12" and thereafter bend the formed plate into the cup shape in a manner not disclosed. Why is it assumed that a reverse teaching can yield claim 5? The Board never tells us.

This RCE has been filed for the purpose of conducting an interview with the examiner to discuss the points raised above and to explore the possibility of achieving an allowance of claims 5 and 6 along with claim 8. At the interview, further amendments to claim 5 can be considered. These further amendments to claim 5 can be presented to the examiner before the interview. Also, since Mr. Kanemitsu is a co-inventor of the invention disclosed and claimed in U.S. Patent No. 5,396,787 and the invention disclosed and claimed herein, a declaration from Mr. Kanemitsu and Mr. Oda can be presented which will state that the configuration of Fig. 4 of the '787 patent was not intended to be formed as is the member of the present invention.

Respectfully submitted,


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MARKED-UP COPY OF THE AMENDMENT TO THE FIRST FULL PARAGRAPH ON
PAGE 8 OF THE SPECIFICATION

– Figs. 2 to 5 show stages [of a step] or three steps in which the disc member 11 is held between a circular bottom pattern tool 33 and a circular top pattern tool 34, and the flange-shaped portion 13 is gradually thickened by using circular rollers 35 to 38 of several [kinds] configurations.--